Applicant(s): Volker Deichmann
Appl. No.:   10/019,329
Conf. No.:   6261
Filed: May 9, 2002
Title: MOBILE PHONE WITH EXPANDED TELEPHONE DIRECTORY
Art Unit: 2618
Examiner: Tuan A. Tran
Docket No.:   112740-372

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated December 26, 2006 pursuant to 37 C.F.R. § 41.41(a). Appellants respectfully submit the Examiner's Answer has failed to remedy the deficiencies with respect to the Final Office Action dated October 20, 2005 as noted in Appellants' Appeal Brief filed on September 18, 2006 for at least the reasons set forth below. Accordingly, Appellants respectfully request that the rejections of pending Claims 9-16 be reversed.

II.   A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED WITH RESPECT TO THE COMBINATION OF *HOLMSTOM* AND *IWATA*

a.   The skilled artisan would not be motivated to combine *Holmstom* with *Iwata* to arrive at the present claims

Appellants respectfully request that the Board reverse the section 103 rejections because the Examiner has still failed to provide sufficient motivation or suggestion for one having ordinary skill in the art to combine the cited references to arrive at the present claims without using hindsight.   Moreover, Appellants respectfully submit that the Examiner has failed to consider the references as a whole and those portions teaching away from the combination. Instead, it is respectfully submitted that the Examiner has improperly attempted to combine references that have different intended purposes and modes of operation.

Holmstrom discloses that "[t]he object of the invention is to enhance the use of the phone book in mobile phones by simplifying the steps that a user have [sic] to go through in order to utilize complex operations . . . [by selecting] more than one item in the phone book and thereafter select an operation to be executed on all selected items" (page 1, lines 23-29, emphasis added).   To manage the execution of operations, *Holmstrom* teaches that flagged names or telephone numbers in the phone book that have abbreviated numbers are stored in the non-volatile memory (EEPROM), while non-flagged entries are stored in the SIM card (page 3, lines 5-8). Accordingly, *Holmstrom* performs memory management for the phone book by separating SIM and EEPROM entries and performing abbreviated dialing functions according to the selected function and the location of the entry (page 4, lines 5-31).

In contrast, *Iwata* discloses a "tag area 28" (FIG. 6), but does not disclose how the tags are created or managed within the overall system. As demonstrated previously, Iwata is wholly silent regarding the use of SIM cards, and is instead directed to computer processor, or PDA, type devices containing touch pads, where the address books are integrated into RAM memory (col. 13, lines 9-34). Nevertheless, Iwata shows that, in the context of an address book, the user is provided with a list of names for an overview of certain address book entries according to a chosen index, wherein, by double touching one of the list entries, a corresponding address to this entry is scrolled and displayed (col. 14, line 4 – col. 15, line 13; see FIGs. 6 and 7).   This configuration in *Iwata* merely discloses a scrolling function for locating stored names within an

address book through their alphabetical order (A-Z) or their Japanese/English phonetic equivalent ("KA," SA," "TA," etc.) (col. 14, lines 26-42). From the disclosure provided in connection with various functions of FIGs. 6-8, and 10-12 (TALK LOG, MEMO, SCHEDULE, ADDRESS BOOK, and TELEPHONE; col. 14, lines 17-42; col. 15, lines 15-25; col. 15, line 62 - col. 16, line 36) *each of the entries are already tagged, when displayed to the user*.

The Examiner's Answer states that "[s]ince both *Holmstrom & Iwata* teach about the mobile phone having telephone directory; they are combinable and their combination will create expansion telephone directory, as taught by Iwata, for the telephone directory stored in the memory of the mobile phone as disclosed by *Holmstrom* in order to allow users to store additional information associated with the telephone directory" (see page 6 of Examiner's Answer). The Applicant respectfully submits that this analysis ignores the fact that (1) all of Iwata's entries are tagged, while *Holmstrom* processes information through tagged and untagged entries, and (2) Iwata does not use SIM cards, while *Holmstom* navigates between the SIM and the EEPROM, and (3) the "expanded telephone directory" of Iwata has no bearing on *Holmstom's* configuration, *which uses an abbreviated directory in the first place*. It is not understood how the stated object of *Holmstrom* (i.e., establishing a simplified menu for executing operations) is furthered by "expanding" the directory as disclosed in Iwata.

III. NEITHER HOLMSTROM NOR IWATA TEACH OR SUGGEST EVERY ELEMENT OF THE CLAIMED INVENTION

a.   The Examiner has not properly interpreted the present claim language.

Appellants respectfully request that the Board reverse the section 103 rejections because the Examiner has still failed to provide sufficient evidence that each and every limitation of the present claims is disclosed by *Holmstom* and *Iwata*. In this regard, the Examiner has failed to properly interpret the claim language and specifically the claimed electronic telephone directories.

The Examiner's Answer states that the claimed features are not narrow enough to prevent the database from being assigned to the directory of the mobile phone (see page 7). Applicant notes that claim 9 recites "at least one electronic telephone directory . . . being stored in a

memory of the SIM card and <u>another</u> of the at least one electronic telephone directory, if applicable, being stored on the non-volatile memory" (emphasis added). Claim 9 further recites that the database is "respectively assigned to one of the at least one electronic telephone directory, wherein . . .". Thus, the database relates to the electronic telephone directory of the SIM card, and not the non-volatile memory (i.e., "another . . . directory"). Thus, contrary to the examiner's interpretation, the plain language of the claim makes clear that the database is not assigned to the non-volatile memory.

b.   *Holmstom* and *Iwata* also fails to disclose or suggest other elements of the present claims

As mentioned argued previously, independent Claim 9 recites a telephone directory stored in a SIM card and another directory (if there is more than one), stored in non-volatile memory, where the telephone directory has its attributes prescribed by the SIM card. Claim 9 further recites at least one database stored in non-volatile memory that corresponds to a respective telephone directory, where each database has a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry. Accordingly, the format of the number of attributes which has been previously prescribed by the SIM card can be expanded via the "additional" attributes (such as grouping telephone numbers according to certain properties such as "work" or "personal").

As was already conceded, *Holmstrom* does not teach an electronic data base assigned to the telephone directory in the SIM card in order to expand the prescribed structure of the telephone directory in the SIM card with respect to the structure of the telephone directory entries (see Final Office Action dated October 20, 2005: page 2, paragraph 1).

As was discussed above, *Iwata* discloses a mobile phone providing an address book solely within RAM memory, where the user is provided with a list of names for an overview of certain address book entries according to a chosen index, wherein by double touching one of the list entries a corresponding address to this entry is scrolled and displayed (col. 14, line 4 – col. 15, line 13; see FIGs. 6 and 7). Since the configuration in *Iwata* merely discloses a scrolling function for locating stored names within an address book through their alphabetical order (A-Z) or their Japanese/English phonetic equivalent ("KA," SA," "TA," etc.) (col. 14, lines 26-42), the

display in Iwata is directed towards the <u>same attribute</u> (i.e., name), and does not provide for any additional attributes. *Iwata* also does not disclose a database being respectively assigned to one of the at least one electronic telephone directory <u>stored in the memory of a SIM card</u> as required in the present claims (see *Iwata*: col. 13, lines 19-21; col. 18, lines 9-20; FIG. 30 – col. 26, lines 29-48). As such, the reference does not disclose at least one data base stored in a <u>non-volatile memory</u>, wherein the at least one database is assigned to one specific electronic telephone directory to expand the telephone book structure.

    For the reasons discussed above, the combination of *Holmstom* and *Iwata* is improper. Moreover, even if combinable, *Holmstom* and *Iwata* do not teach, suggest, or even disclose all of the elements of Claim 9, and the dependent claims. Accordingly, Appellants respectfully submit that Claims 9-16 are novel, nonobvious and distinguishable from the cited references and are in condition for allowance.
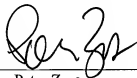
V. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the Final Office Action. Therefore, Appellants respectfully request that the Board of Appeals reverse the anticipation and obviousness rejections with respect to Claims 9-15.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112740-372 on the account statement.

Respectfully submitted,

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Dated: February 26, 2007